



PATENT  
ORCL.P0073

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Vincent Tassinari

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application for:

Mohammad FAISAL

Serial No.: 09/742,809

Filing Date: 12/19/2000

For: AUTOMATED EXTENSION FOR  
GENERATION OF CROSS REFERENCES  
IN A KNOWLEDGE BASE

examiner: Neveen ABEL JALIL

Group Art Unit: 7301

**REPLY BRIEF**

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Sirs:

This is a Reply Brief filed under 37 CFR 1.193(b)(1) in response to the July 26, 2004  
examiner's answer (Paper No. 14).

**BACKGROUND**

Appellant appealed from the December 19, 2003 (Paper No. 12) rejection of claims 1-15,  
5 all the claims pending in the instant application.

The invention relates to a method to automatically generate cross-references among  
categories in a knowledge base based on themes from documents. With document theme scores  
generated from themes in a document, document theme pairs are selected based on the document

theme score. The two document themes of a document-theme-score-selected theme pair are mapped to corresponding categories in the knowledge base to select a knowledge base category pair. A cross reference between the two categories of the particularly selected knowledge base category pair is generated where that cross reference identifies an association, such as a linguistic, semantic, or usage association, between the two categories.

**Claim 1** is illustrative of the claims on appeal:

1. A method for generating cross-references among categories in a knowledge base, said method comprising the steps of:
  - extracting, from a plurality of documents, a plurality of themes, wherein a theme identifies subject matter contained in a corresponding document;
  - generating a theme strength for said themes, said theme strength reflects the amount of subject matter contained in a document for a corresponding theme relative to other themes in said document;
  - generating a plurality of scores, from said theme strengths, to identify a relative theme pair strength for at least one pair of said themes extracted from said documents;
  - selecting theme pairs based on said scores;
  - selecting category pairs in said knowledge base by mapping said themes of said theme pairs selected to corresponding categories of said knowledge base; and
  - generating a cross reference in said knowledge base between categories of said category pairs, wherein said cross reference identifies an association between said category pairs.

### **Procedural History**

Appellant finds it helpful to outline the procedural history of this application.

1. On March 21, 2003, the examiner entered a final rejection of claims 1-15 under 35 U.S.C. § 102(b) as being anticipated by Wical (US Patent No. 5,953,718) (Wical '718) (Paper No. 6) (the second Office action).

2. On June 6, 2003, Appellant filed a Response to the March 21, 2003 Final Rejection. Additionally, Appellant filed a Notice of Appeal with the Response.

3. On June 26, 2003, the examiner mailed an Advisory Action (Paper No. 9) that maintained the rejections in March 21, 2003 Final Rejection.

4. On September 9, 2003, Appellant filed an appeal brief.

5. On December 19, 2003, the examiner reopened prosecution in view of the arguments in Appellant's September 9, 2003 appeal brief to enter a new ground of rejection through a non-final rejection (Paper No. 12) (the third Office action) (pages referred to as "NFR\_\_"). In Paper No. 12, the examiner rejected claims 1-15 under 35 U.S.C. § 102(b) as being anticipated by Wical (US Patent No. 5,930,788) (Wical '788). The examiner failed to repeat or sufficiently refer to the rejections of Paper No. 6 (the second Office action) in this Paper No. 12 (the third Office action).

6. On April 21, 2004, Appellant exercised its option under 37 CFR 1.193(b)(2)(ii) to reinstate the appeal and filed a supplemental appeal brief (Paper No. 13) in response to the December 19, 2003 non-final rejection.

7. On July 26, 2004, the examiner mailed an examiner's answer (Paper No. 14) (pages referred to as "EA\_\_"). The examiner failed to repeat or sufficiently refer to the rejections of the third Office action (Paper No. 12) in this Paper No. 14 (the examiner's answer). Moreover, the examiner's answer attempts to enter a new ground of rejection as well as reassert all the rejections that Appellant previously overcame during prosecution.

8. On August 24, 2004, Appellant filed this Reply Brief and a petition to prohibit entry of the grounds of rejection in the examiner's answer.

## REPLY ARGUMENTS

### I. SINCE THE EXAMINER HAS WITHDRAWN ALL REJECTIONS TO THE CLAIMS, THE CLAIMS ARE ALLOWABLE

Under MPEP § 707.07(e), every point in the prior action of an examiner that is still applicable must be repeated or referred to, to prevent the implied waiver of the requirement. *See Ex Parte Edward Fu, Ratana K. Chaudhuri and Kolazi S. Narayanan*, 1995 WL 1696771, Bd.Pat.App & Interf. Appeal No. 95-2233 (1995) (Application 07/978,014) ("The only reasonable interpretation which these facts permit is that the examiner dropped all rejections set forth in the Final Rejection except the rejections specifically referred to in the examiner's answer. *See Paperless Accounting, Inc. V. Bay Area Rapid Transit System*, 804 F.2d 659, 663 (Fed. Cir. 1986)"). *See also, Ex Parte Howard W. Long*, Dec'd, 1997 WL 33107232, FN2, Bd.Pat.App & Interf. Appeal No. 1997-2277, FN2 (1997) (Application 08/462,814) (The examiner does not repeat or refer to the rejection in the examiner's answer. Therefore, as a matter of standard procedure, the previously entered rejection of claim 6 has been withdrawn). *And see, Ex Parte Robert F. Garfield and Krostof Chawalisz* 2004 WL 77127, Bd.Pat.App & Interf. Appeal No. 2001-0982 (2004) (Application 08/310,950) ("Since this other ground of rejection was not included in the examiner's answer, we assume that this ground of rejection has been withdrawn by the examiner. *See Ex parte Emm*, 118 USPQ 180, 181 (Bd. App. 1957)").

As noted above, the examiner failed to repeat or sufficiently refer to the rejections of Paper No. 6 (the second Office action) in Paper No. 12 (the third Office action). Since the examiner failed to repeat or refer to in the third Office action every point in the second Office action that is still applicable, the examiner withdrew all rejections set forth in the second Office

action (Paper No. 6). MPEP § 707.07(e). Also as noted above, the examiner failed to repeat or sufficiently refer to the rejections of the third Office action (Paper No. 12) in Paper No. 14 (the examiner's answer). Since the examiner failed to repeat or refer to in the examiner's answer every point in the third Office action that is still applicable, the examiner withdrew all rejections set forth in the third Office action (Paper No. 12). MPEP § 707.07(e).

This is an appeal from the rejections set forth in the third Office action (Paper No. 12). Since this is an appeal from the rejections set forth in the third Office action and since the examiner withdrew all rejections set forth in the third Office action, the claims are allowable. Accordingly, Appellant respectfully requests that the Board allow claims 1-15, all the claims pending in the instant application.

## II. CLAIMS 1-15 ARE NOT ANTICIPATED BY WICAL '788

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing. MPEP 706.07 Towards this end, 37 CFR 1.104 (MPEP 707.07) requires that the examiner's action be complete as to all matters. Moreover, as noted in MPEP 706.07, switching from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will tend to defeat attaining the goal of reaching a clearly defined issue for an early termination.

Appellant does not believe that it has had a full and fair hearing. The examiner's answer attempts to enter a new ground of rejection as well as reassert all the rejections that Appellant previously overcame during prosecution. This has compelled Appellant to spend the time to prepare and file a petition to prohibit entry or reassertion of the grounds of rejection in the examiner's answer in addition to preparing and filing this reply brief. The prosecution has splintered out into a petition and an appeal, the results of which have the potential to further

splinter this prosecution. Without waiving any rights and to hopefully focus and move this prosecution along, Appellant provides the following with regard to the Paper No. 12.

In Paper No. 12, Claims 1-15 were rejected under 35 U.S.C. § 102(b) as being anticipated by Wical (US Patent No. 5,930,788) (Wical '788).

5           A.     selecting theme pairs based on said scores: Regarding claim 1, Wical '788 does not teach selecting document theme pairs based on the document theme score. In fact, Wical '788 does not even teach selecting document theme pairs. Wical '788 teaches extracting theme concepts and parent theme concepts from knowledge catalog 150 (Wical '788 col. 7, lines 24-25). The examiner cites Wical '788, col. 11, lines 35-65 as teaching selecting document theme pairs  
10   based on the document theme score (NFR3, line 10). Although Wical '788 teaches pairing knowledge catalog 150 theme concepts and knowledge catalog 150 parent theme concepts (Wical '788, col. 11, lines 35-65), Wical '788 fails to teach selecting document theme pairs. To the extent that Wical '788 teaches pairing knowledge catalog 150 theme concepts and knowledge catalog 150 parent theme concepts, the pairing is based on all available permutations (Wical '788,  
15   col. 9, lines 7-9 and col. 21, lines 23-25, claim 13) rather than on document theme score.

          B.     selecting category pairs in said knowledge base by mapping said themes of said theme pairs selected to corresponding categories of said knowledge base: Additionally regarding claim 1, Wical '788 does not teach mapping the two document themes of a document-theme-score-selected theme pair to corresponding categories in a knowledge base to select a knowledge  
20   base category pair.

The examiner cites Wical '788, col. 14, lines 24-52 as teaching mapping two document themes to corresponding categories in a knowledge base (NFR3, lines 11-13). This is insufficient to teach the claimed limitation since the two document themes are not from a document-theme-score-selected theme pair. The examiner cites Wical '788, col. 11, lines 23-34

as teaching selecting a knowledge base category pair. Even if Wical '788 teaches pairing knowledge catalog 150 theme concepts and knowledge catalog 150 parent theme concepts, the pairing is not based on a document-theme-score-selected theme pair as recited in the claim.

C. generating a cross reference in said knowledge base between categories of said

5 category pairs, wherein said cross reference identifies an association between said category

pairs: Further regarding claim 1, Wical '788 does not teach generating a cross reference between the two categories of a particularly selected knowledge base category pair where that cross reference identifies an association between the two categories (such as a linguistic, semantic, or usage association - Specification, page 55, lines 7-8).

10 The examiner cites Wical '788, col. 21, lines 23-25, claim 13 as teaching the claimed association. However, the category pairs in Wical '788 claim 13 are the result of all possible permutations of category pairs (e.g. combining a first classified category with each other classified category). Even if a first Wical '788 classified category is "associated" with a second Wical '788 classified category, the pairing is not an identified association as recited in claim 1.

15 **III. CONCLUSION**

In view of the above, Appellant asserts that all pending claims, claims 1-15, are in condition for allowance and respectfully requests that the Board grant the same.

Dated: August 24, 2004

Respectfully submitted,

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